

**REMARKS**

Applicant respectfully submits this Amendment in response to the non-final Office Action mailed on October 6, 2009.

In the Office Action, claim 7 was rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter; claims 1-3 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Yamaqishi et al. (U.S. Patent No. 6,141,491); and claims 4-7 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yamaqishi et al. in view of Nagata (U.S. Patent No. 5,974,224).

By this Amendment, Applicant amends claims 1-7, and adds new dependent claims 8-20. After entry of this Amendment, claims 1-20 will remain pending in this application. Of those, claims 1-4, 6, and 7 are the sole independent claims.

Applicant respectfully traverses the rejections, and submits that the pending claims are now in condition for allowance, for at least the reasons set forth below.

**Rejection of Claim 7 under 35 U.S.C. § 101**

Claim 7 stands rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter, for reciting "a program without specifying the location of the program and/or the program is stored on a computer readable medium and executed by a computer." (Office Action, page 2).

By this Amendment, Applicant has amended claim 7 (and also claim 3) to recite a, "computer-readable storage medium" for storing the claimed program. Accordingly, Applicant respectfully submits that both of claims 3 and 7 are directed to statutory subject matter and requests that the rejection of claim 7 under 35 U.S.C. § 101 be withdrawn.

**Rejection of Claims 1-3 under 35 U.S.C. § 102(b)**

Applicant respectfully traverses the rejection of claims 1-3 under 35 U.S.C. § 102(b) as allegedly being anticipated by Yamagishi et al. Applicant submits that currently amended independent claims 1-3 are patentably distinguishable over Yamagishi et al. at least for the reasons set forth below.

In order to properly establish that Yamagishi et al. anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of independent claim 1 must be disclosed, either expressly or under principles of inherency, in that single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Office Action asserts that Yamagishi et al. discloses all of the features of claims 1-3 including, "an image playback apparatus (Figs. 3, 7-9, column 13, 14, column 19-20) that plays back moving picture data...comprising: buffering means (50) for buffering the moving picture data; decoding means (70) for reading out and decoding the moving picture data buffered by the buffering means; outputting means for outputting pictures decoded by the decoding means to a subsequent stage; and controlling means (90)..." (Office Action, pages 2-3.) Applicant respectfully disagrees.

Although Applicant agrees that Yamagishi et al. discloses a buffer 50, decoders 20, 70, and read controller 90, Yamagishi et al. does not teach or suggest (and indeed the Office Action fails to assert such disclosure of), at least:

"controlling the buffer unit to buffer, concerning a group of picture data that is played back last during a playback operation, at least picture data located at the end in a playback order, and to buffer, concerning groups of picture

data except for the group of picture data that is played back last during the playback operation, picture data encoded by a predetermined encoding method,

controlling the decoder to decode, concerning the group of picture data that is played back last during the playback operation, at least the picture data located at the end in the playback order, and to decode, concerning the groups of picture data except for the group of picture data that is played back last during the playback operation, the picture data encoded by the predetermined encoding method, and

controlling the output unit to output, concerning the group of picture data that is played back last during the playback operation, at least the picture data located at the end in the playback order, and to output, concerning the groups of picture data except for the group of picture data that is played back last during the playback operation, pictures corresponding to the picture data encoded by the predetermined encoding method (emphasis added)"

as recited in each of independent claims 1-3.

Therefore, Yamagishi et al. fails to anticipate each and every element of independent claims 1-3, and Applicant respectfully requests that the rejection of claims 1-3 under 35 U.S.C. § 102(b) be withdrawn. Newly-added claims 11-13, 14-16, and 17-19 depend from claims 1, 2, and 3, respectively, and are therefore patentable for at least all of the same reasons that those claims are patentable.

**Rejection of Claims 4-7 under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claims 4-7 under 35 U.S.C. § 103(a), because a prima facie case of obviousness has not been established.

The Office Action asserts that Yamagishi et al. discloses all of the features of claim 4-7 except for "playback the picture data in a reverse mode." In order to cure the deficiencies of Yamagishi et al., the Office Action cites Nagata as disclosing "a control means for reproducing the picture data in a reverse mode," and asserts that it "would

have been obvious to one of ordinary skill in the art to modify Yamaqishi et al. with [Nagata]...thereby enhancing the capacity of the apparatus of Yamaqishi et al."

Applicant respectfully disagrees.

Nagata fails to cure the deficiencies of Yamaqishi et al. as described above.

Therefore, even if Nagata were to teach what the Office Action alleges it does (which Applicant does not necessarily concede), neither Yamaqishi et al. nor Nagata, either alone or in combination would disclose each and every element of independent claims 4, 6, and 7, including at least a method and control unit configured for:

"controlling the buffer unit to buffer, concerning a last group of picture data in a normal playback order, all of the picture data, and to buffer, concerning groups of picture data except for the last group of picture data, part of the picture data including at least picture data classified into the I-pictures;

controlling the decoder to decode, concerning the last group of picture data, the picture data classified into the I-pictures or the P-pictures, and to decode, concerning the groups of picture data except for the last group of picture data, at least the picture data classified into the I-pictures; and

controlling the output unit to output, concerning the last group of picture data, at least a last picture of moving pictures, and to output, concerning the groups of picture data except for the last group of picture data, at least pictures corresponding to the I-pictures," (emphasis added),

as recited in each of independent claims 4, 6, and 7. Therefore, neither Yamaqishi et al. nor Nagata teaches or suggests each and every element of independent claims 4, 6, and 7, either alone or in combination, and Applicant respectfully requests that the rejection of independent claims 4, 6, and 7 under 35 U.S.C. § 103(a) be withdrawn.

To the extent that the Examiner is assigning no weight to the elements and functionality of the claimed "control unit," Applicant responds as follows. Applicant

maintains that the standard for anticipation under Section 102 is not whether a control circuit discussed in a reference is capable of performing operations that are claimed. Rather, a finding of anticipation requires that there must be no difference between the claimed invention and the disclosure of the cited reference as viewed by one of ordinary skill in the art. See *Scripps Clinic & Research Foundation v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Accordingly, the theoretical capabilities of the control circuit in Yamagishi et al. cannot be the basis of a rejection under section 102.

Moreover, established case law provides that an assertion that the prior art is capable of some function is not sufficient without an explanation (from the Examiner) regarding how the prior art elements perform each claimed function even though the prior art is structurally different. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim limitations regarding organization of data in memory held to distinguish over prior art). See also *In re Alappat*, 33 F.3d 1526, 1545, 31 USPQ2d 1545, 1558 (Fed. Cir. 1994) (commenting that prior cases held that computer, once programmed, creates a new machine); *In re Noll*, 545 F.2d 141, 148, 191 USPQ 721, 726 (CCPA 1976) ("[The claimed invention] comprises physical structure, including storage devices and electrical components uniquely configured to perform specified functions through the physical properties of electrical circuits to achieve controlled results. Appellant's programmed machine is structurally different from a machine without that program.") (emphasis added).

Both the "organization of data in memory" and "programmed" devices, such as controllers and processors, have been held to impart structure. Accordingly, contrary to

the implicit assertions in the Office Action, the programmed operations of the independent claims do recite structural differences over Yamagishi et al.

**New Claims 8-20**

New claims 8-20 all depend either directly or indirectly from one of independent claims 1-4, 6, and 7, which are allowable for at least the reasons discussed above. Therefore, new claims 8-20 are allowable at least due to their dependence from an independent claim and for their additional recitations of patentable subject matter. Applicant respectfully requests that claims 8-20 be allowed.

**Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Should it be necessary to resolve any additional concerns and expedite the issuance of a Notice of Allowance, the Examiner is invited to contact Applicant's undersigned representative at (202) 408-4252.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: January 6, 2010

By: 

Christopher K. Agrawal  
Reg. No. 63,482